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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,354

02/06/2002

Joseph A. Kozlowski

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SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
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EXAMINER

COPPINS, JANET L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

06/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/072,354	Applicant(s) KOZLOWSKI ET AL.	
	Examiner Janet L. Coppins	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-85, 87, 88 and 90-129 is/are pending in the application.
- 4a) Of the above claim(s) 87, 88, 91-111 and 127 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61 and 129 is/are rejected.
- 7) ☒ Claim(s) 62-85, 90, 112-126 and 128 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 61-85, 87, 88, and 90-129 are now pending in the instant application.

Information Disclosure Statement

2. Applicants' Information Disclosure Statement (IDS), submitted March 27, 2007, has been considered by the Examiner. Please refer to the signed copy of Applicants' PTO-1449 form, submitted herewith. The Examiner also notes that a signed copy of the PTO-1449 form of the IDS of September 22, 2003 is not present in the file wrapper, therefore a newly signed copy is provided herewith.

Response to Amendment

3. Receipt is acknowledged of Applicants' Amendment and Response of March 27, 2007, which has been reviewed by the Examiner and entered of record in the file. Accordingly, claims 86 and 89 have been cancelled, claims 61, 62, 87, 88, and 90-111 have been amended, and new claims 127-129 have been added (claim 127 will be withdrawn as directed to methods of use, and claims 128 and 129 will be added into Group I, drawn to compounds). Claims 87, 88, 91-111, and 127 will remain withdrawn from consideration as drawn to non-elected inventions.

Status of the Claims

4. Claims 61-85, 90, 112-126, 128 and 129 are currently pending before the Examiner. Claims 87, 88, 91-111 and 127, drawn to methods of use and pharmaceutical compositions containing additional ingredients, are currently withdrawn from consideration by the Examiner, as stated above. The Examiner had previously indicated that the scope of the invention of the elected subject matter consisted of compounds according to the formula of claim 61, wherein: **R⁴** is limited to optionally substituted phenyl rings, and the remaining variables are as defined in the

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claims. The remaining subject matter of claims 61-85, 90, and 112-126 was **withdrawn** from consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions (i.e. compounds and compositions within claims 66-68 and 90 that contained other than phenyl rings for the R⁴ position).

However, in view of Applicants' amendatory changes to the claims in order to obviate the art rejections, the Examiner will expand the scope of the invention of the elected subject matter to include all compounds of the formula of claim 61, i.e. the scope is no longer limited by the definition of the R⁴ substituent.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. (a) Claim 61 in part previously rejected under 35 U.S.C. 102(b) as being anticipated by Joseph, K. Abraham et al, Polymer International.

(b) Claim 61 in part previously rejected under 35 U.S.C. 102(b) as being anticipated by Malichenko, B.F. et al, Zhurnal Organicheskoi Khimii.

In view of Applicants' amendment to claim 61 in order to proviso out the anticipated subject matter, the above 35 U.S.C. 102(b) rejections are withdrawn.

However, pursuant to the expanded scope of examined subject matter, the following art rejections are applied:

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7. Claim 61 in part newly rejected under 35 U.S.C. 102(b) as being anticipated by Ivanova, V. M. et al, Monomery dlya Polikondensatsii, Tula (1979). The Ivanova et al journal article discloses biphenyl compounds that are the same as the compounds of the instant claims, wherein Applicants' L^1 would be sulfur; L^2 would be sulfonyl, R^1 and R^2 are methyl; R^3 is not present; R^4 is methyl; R^5 and R^6 form a carbonyl group; and Y and Z are covalent bonds, please refer to the compound of RN 78258-98-7, for example (see the attached abstract).

8. Claim 129 in part rejected under 35 U.S.C. 102(b) as being anticipated by Malichenko, B.F. et al, Zhurnal Organicheskoi Khimii. The Malichenko et al journal article discloses triphenyl compounds that are the same as the compounds of the instant claims, wherein Applicants' L^1 and L^2 would be sulfonyl, R^1 is hydrogen; R^3 is not present; R^4 is phenyl substituted by X, wherein X is $-\text{CON}(\text{R}^2)_2$ and R^2 is hydrogen; R^5 and R^6 form a carbonyl group; and Y is a covalent bond, please refer to the compound of RN 55709-49-4, for example.

Claim Objections

9. Claims 62-85, 90, 112-126 and 128 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. In conclusion, claims 61-85, 87, 88 and 90-129 are pending, claims 87, 88, 91-111 and 127 are currently withdrawn from consideration, claims 61 and 129 are rejected, and claims 62-85, 90, 112-126 and 128 are objected to.

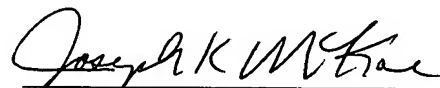
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Coppins
June 10, 2007



Joseph K. McKane
SPE, Art Unit 1626